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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
1740-000011/US/COA

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/810,720

Filed

March 29, 2004

First Named Inventor

Byung-Jin KIM

Art Unit

2621

Examiner

Robert Chevalier

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 35,416

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Gary D. Yacura, Reg. No. 35,416

Typed or printed name

703/668-8023

Telephone number

October 25, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of 3 forms are submitted.



PATENT  
1740-000011/US/COA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Byung-Jin KIM Confirmation No.: 9364  
SERIAL NO.: 10/810,720 Group Art Unit: 2621  
FILED: March 29, 2004 Examiner: Robert Chevalier  
FOR: METHOD OF REPRODUCING A STILL PICTURE FROM A  
RECORDING MEDIUM, METHOD OF DECODING THE STILL  
PICTURE AND THE RECORDING MEDIUM

**REASONS SUPPORTING REQUEST FOR PRE-APPEAL BRIEF  
CONFERENCE**

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
**Mail Stop Amendment**

October 25, 2007

Dear Sir:

Further to the concurrent filing of a Notice of Appeal, the following remarks are submitted in support of Appellant's Request for Pre-Appeal Brief Conference.<sup>1</sup>

Claims 1-6 and 10-25 are pending.

**Section 101 Rejection**

Claims 10-12, 15-18, 22 and 25 stand rejected under 35 U.S.C. §101 as being directed to a recording medium storing nonfunctional descriptive material. Applicants respectfully traverse this grounds of rejection.

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<sup>1</sup> Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005.

First Applicants direct the conference members to the detailed arguments submitted in the Response filed July 20, 2007.

In the Advisory Action dated August 24, 2007, the Examiner states:

As indicated in the Final Office Action mailed out on 4/25/07, merely claiming nonfunctional descriptive material stored on a computer readable medium does not make it statutory. Applicant's attention is directed to the fact that the claimed invention does not have any computer program stored in the computer readable medium which programs when read by the computer would allow the management data to perform the reproduction operation as indicated in the claimed invention.

The Examiner appears to be operating under the mistaken belief that data structures are not functional descriptive material. This is simply incorrect. Applicants demonstrated quite clearly in the July 20, 2007 response, with reference to the MPEP and case law, that data structures can define functional descriptive material and thus claims to data structures can recite statutory subject matter. Still further, applicants demonstrated that the subject claims define data structures, which are functional descriptive material and statutory subject matter.

### **Art Grounds of Rejection**

Claims 1-6 stand rejected under 35 U.S.C. §102(e) as being anticipated by Mishima (U.S. Publication No. 2002/0090207); and claims 10-25 stands rejected under 35 U.S.C. §103 as being unpatentable over Juri (U.S. Patent No. 5,999,693) in view of Official Notice. Applicants respectfully traverse these art grounds of rejection.

First applicants the direct conference members to the detailed arguments submitted in the Response filed July 20, 2007.

In the Advisory Action dated August 24, 2007, the Examiner states:

Moreover, with regard to the Applicant's request of the Examiner to produce prior art reference that supports the Official Notice of a management area being located separately from the area where the video data are recorded on the recording medium, Applicant's attention is directed to Suzuki et al's Figure 9 (P.N. 2005/0180731), and Kikuchi et al's claim 1 (2007/0133948). Moreover, it is to be noted that Mishima et al at page 8, paragraph [0073], lines 9-13 clearly disclose the capability of outputting a picture during a playback operation.

#### Mishima

The Examiner has relied on paragraph [0073] of Mishima before – see page 6, of the April 25, 2007 Final Office Action. Mishima teaches the following in paragraph [0073]:

At the time of the special playback, only the data of the I picture and the P picture are read in the unit of area, and regions of areas 1, 2, - - - , n are read from continuous n I pictures and P pictures to synthesize a picture of one screen portion and is outputted as a playback picture.

Furthermore, the disclosure in paragraphs [0061] – [0067] makes clear that the "special playback" is a form of high speed playback. Namely, Mishima teaches synthesizing one screen during special playback from I and P pictures. Mishima discloses nothing with respect to still pictures, and the Examiner has not shown that Mishima discloses or suggests reproduction of a still picture. As such, Mishima fails to anticipate or render claim 1-6 obvious to one skilled in the art.

#### Juri in view of Official Notice

To support his Official Notice, the Examiner cites Suzuki et al's Figure 9 (P.N. 2005/0180731) and Kikuchi et al's claim 1 (2007/0133948). First, Suzuki does not qualify as prior art. Applicant's perfected their claim to priority by previously submitting a certified

translation of their priority document; and therefore, are entitled to a filing date of at least October 30, 1999.

However, even assuming Suzuki and Kikuchi qualify as prior art, neither teaches a table of contents "storing management data for managing reproduction of the video data, the management data indicating if the video data does not include a still picture" as recited in claim 10. And, neither Juri nor the knowledge of one skilled in the art provides such a teaching or suggestion.

On page 4 of the April 25, 2007 Final Office Action, the Examiner notes that Juri does not disclose or suggest "a management area, separated from the data area and not included in a header for the video data in the data area, storing management data for managing reproduction of the video data, the management data indicating if the video data does not include a still picture" as recited in claim 10.

As stated in their July 20, 2007 response, Applicants do not dispute that a list of titles known as a table of contents exists. However, the Examiner has failed to show that such tables include the type of management information claimed or the type of management information taught in Juri. Accordingly, Applicants challenge the Examiner to produce a prior art reference that supports his Official Notice of a table of contents consistent with his allegations.

Stated another way, there is no nexus between a list of titles on a recording medium (i.e., a table of contents) and "the management data including information for managing reproduction of the video data, and the management data indicating if the video data does not include a still picture," as recited in claim 10. As such, there is no plausible explanation why a list of titles would have been modified to include such information.

Juri teaches that the still image flag is part of the first video auxiliary data that is connected to the main video data. Namely, the still image flag is part of a header for the main video data. Juri teaches this structure for increasing access speed. Accordingly, the Examiner's alleged motivation for modifying Juri to "improve speed of accessing data on the recording medium as suggested in the prior art" is counter to Juri's teachings and not an obvious modification.

For the reasons set forth above and in the July 20, 2007 response, Juri also fails to render claims 11-25 obvious to one skilled in the art.

### ***CONCLUSION***

In view of above remarks, reconsideration of the outstanding rejections and allowance of the pending claims is respectfully requested.

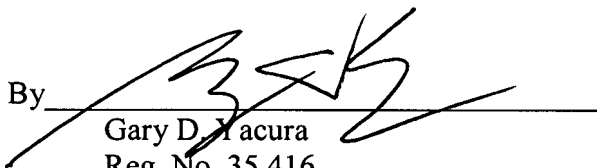
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, PLC

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